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TECH CENTER PATENT
CUSTOMER 100020852

Attorney Docket No. 03806.0424-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Luc CHANTELOUP et al.) Group Art Unit: 1625
)
Serial No. 09/836,326) Examiner: B. TRINH
)
Filed: April 18, 2001)
)
For: INTERMEDIATES FOR THE)
HEMISYNTHESIS OF TAXANES)
AND PREPARATION)
PROCESSES THEREFOR)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

In an Office Action dated April 7, 2003, the Examiner maintained the restriction requirement made on October 30, 2002, and required an election of species for examination. Office Action at page 2. Moreover, the Examiner declared moot Applicants' Response to Restriction Requirement filed on November 25, 2002. Office Action at page 2. Accordingly, Applicants hereby respond to the restriction requirement of October 30, 2002, and the election requirement of April 7, 2003.

Applicants provisionally elect to prosecute Group I, claims 12-14, with traverse and elect the species of Example 8, found on page 43 of the specification, with traverse.

Applicants traverse the restriction requirement on the ground that the claims would not be unduly burdensome to search as written. See M.P.E.P. § 803. "[A]

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serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification," among other things. *Id.* Here, the Examiner has not shown entirely separate classification. Instead, Groups I, II, and III are listed as falling within class 549, among others. Office Action at page 2. Groups II and III are both assigned to class 549, subclass 510. At the very least, Groups II and III should be joined together. Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

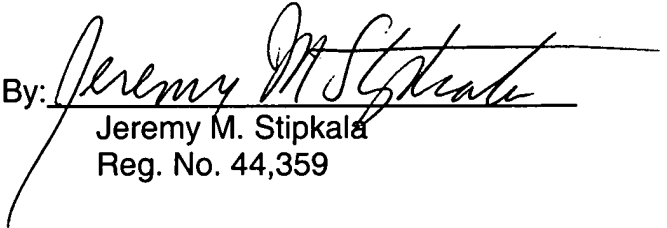
Applicants traverse the election of species requirement on the ground that the claims do not define an unreasonable number of species. Five general formulae appear in claim 12, and each of the formulae share an Ar-C*H-C*H-COOR core. While one species is not necessarily obvious in light of another, the encompassed species amount to a number comparable to those ordinarily included in chemical patent claims.

The Office Action at page 2 states: "Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213." Office Action at page 1. Applicants are not aware that examination on the merits of elected claims has been completed; therefore, the Examiner is requested to clarify the status of this application.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2003

By: 
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